

2854



RECEIVED

SEP 24 2001

DOCKET NO: E6195-0074 CENTER 2800

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: U.S. Application
Serial No: 09/531,497
Filed: March 21, 2000
Group: 2854
Inventor: Yusuke NEMOTO
For: PRINTER

ATTORNEYS AT LAW

GREGORY J. MAIER
(703) 413-3000
GMAIER@OBLON.COM

GAY ANN SPAHN
(703) 413-3000
GSPAHN@OBLON.COM
BAR OTHER THAN VIRGINIA

SIR:

Attached hereto for filing are the following papers:

PROVISIONAL ELECTION

Our check in the amount of \$--0-- is attached covering any required fees. In the event that any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 CFR 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Gay Ann Spahn

Gregory J. Maier
Registration No. 25,599
Attorney of Record
Gay Ann Spahn
Registration No. 34978



22850

Tel: (703) 413-3000
Fax No: (703) 413-2220
GJM:GAS:ycs

I:\atty\gas\Client 6195\Matter 0074\RestrictionRequirement.CoverLtr.wpd

Atty. Docket: 6195-0074-2



RECEIVED

SEP 24 2001

7/
Election
9-24-01
Spruill

IN THE UNITED STATES PATENT & TRADEMARK OFFICE TECHNOLOGY CENTER 2800

IN RE APPLICATION OF : :

Yusuke NEMOTO : GROUP ART UNIT: 2854

SERIAL NO: 09/531,497 : EXAMINER: M. CHAU

FILED: MARCH 21, 2000 : :

FOR: PRINTER : :

PROVISIONAL ELECTION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Restriction Requirement dated September 4, 2001, Applicant provisionally elects, with traverse, to continue prosecution of Group I, claims 1-16, drawn to a printer including a removing member, classified in class 400, subclass 701. Applicant makes this election based on the understanding that Applicant is not prejudiced against filing one or more divisional applications that cover the non-elected claims.

In addition to making this election, Applicant respectfully traverses this Restriction Requirement. In section 806.05(a) of the Manual of Patent Examining Procedure (hereinafter "M.P.E.P.") on page 800-34, a combination is defined as "an organization of which a subcombination or element is a part." Thus, Applicant respectfully submits that:

(1) the inventions of Group I (i.e., characterized in the Restriction Requirement as "a printer including a removing member" and alleged to be a "subcombination") and Group II (i.e., characterized in the Restriction Requirement as "a printer including rotating members having a characteristic

of ink repellent” and alleged to be a “combination”) do not meet the M.P.E.P.’s definition of combination/subcombination because the printer of Group I is not a part of the printer of Group II;

(2) the inventions of Group I (i.e., characterized in the Restriction Requirement as “a printer including a removing member” and alleged to be a “subcombination”) and Group III (i.e., characterized in the Restriction Requirement as “a printer including a switching mechanism, a driving source and a means for controlling the driving source” and alleged to be a “combination”) do not meet the M.P.E.P.’s definition of combination/subcombination because the printer of Group I is not a part of the printer of Group III; and

(3) the inventions of Group II (i.e., characterized in the Restriction Requirement as “a printer including rotating members having a characteristic of ink repellent” and alleged to be a “subcombination”) and Group III (i.e., characterized in the Restriction Requirement as “a printer including a switching mechanism, a driving source and a means for controlling the driving source” and alleged to be a “combination”) do not meet the M.P.E.P.’s definition of combination/subcombination because the printer of Group II is not a part of the printer of Group III.

With respect to Group I (i.e., characterized in the Restriction Requirement as “a printer including a removing member” and alleged to be a “subcombination”) and Group II (i.e., characterized in the Restriction Requirement as “a printer including rotating members having a characteristic of ink repellent” and alleged to be a “combination”), the Restriction Requirement indicates on page 2 that:

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the printer which including [sic] a rotating members [sic] that are [sic] ink repellent in **group II** does not require the use of a removing member in **group I** to be operative. The subcombination has separate utility such as for a printing press. (Emphasis in original).

However, Applicant respectfully submits that the invention of Group I is not a subcombination of the invention of Group II because the claims of Group I are reciting the same printer as the claims of Group II, but in varying scope. More particularly claim 1, which is the only independent claim in Group I, recites a printer including a printing unit, a guide path, a rotating member, and a removing member. Claim 17, which is the only independent claim in Group II, recites a printer including a printing unit, a guide path, and rotating members, wherein one of the rotating members is more narrowly defined as having a periphery made of a material to which ink is not easily adhered.

The differences between claim 1 and claim 17 is that claim 17 is both broader than claim 1 in not reciting the removing means and narrower than claim 1 in more narrowly defining the rotating member. But these differences do not amount to forming a combination and subcombination between claims 1-16 (i.e., Group I) and claim 17 (i.e., Group II). Thus, Applicant respectfully submits that the Restriction Requirement is improper.

With respect to Group I (i.e., characterized in the Restriction Requirement as “a printer including a removing member” and alleged to be a “subcombination”) and Group III (i.e., characterized in the Restriction Requirement as “a printer including a switching mechanism, a driving source and a means for controlling the driving source” and alleged to be a “combination”), the Restriction Requirement indicates on page 3 that:

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the printer in **group III** does not require the use of a removing member in **group I** to be operative. The subcombination has separate utility for other printing devices such as for a printing press. (Emphasis in original).

However, Applicant respectfully submits that the invention of Group I is not a subcombination of the invention of Group III because the claims of Group I are reciting the same printer as the claims of Group III, but in varying scope. More particularly claim 1, which is the only independent claim in Group I, recites a printer including a printing unit, a guide path, a rotating member, and a removing member. Claims 18 and 20, which are two independent claims in Group III, each recite a printer including a printing unit, a guide path, and rotating members, wherein one of the rotating members is more narrowly defined as being either one or two pair of first and second resist rollers, a switching mechanism, a driving source for the switching mechanism, and means for controlling the driving source.

The differences between claim 1 and claims 18 and 20 is that claims 18 and 20 are both broader than claim 1 in not reciting the removing means and narrower than claim 1 in more narrowly defining the rotating member as either one or two pair of first and second resist rollers, a switching mechanism, a driving source for the switching mechanism, and means for controlling the driving source. But these differences do not amount to forming a combination and subcombination between claims 1-16 (i.e., Group I) and claims 18-20 (i.e., Group III). Thus, Applicant respectfully submits that the Restriction Requirement is improper.

With respect to Group II (i.e., characterized in the Restriction Requirement as “a printer including rotating members having a characteristic of ink repellent” and alleged to be a “subcombination”) and Group III (i.e., characterized in the Restriction Requirement as “a printer including a switching mechanism, a driving source and a means for controlling the driving source” and alleged to be “a combination”), the Restriction Requirement indicates on page 3 that:

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the printer in **group II**

does not require the use of a resist rollers and the switching mechanism in **group III** to be operative. The subcombination has separate utility for other printing device [sic] such as for a printing press or screen-printing. (Emphasis in original).

However, Applicant respectfully submits that the invention of Group II is not a subcombination of the invention of Group III because the claim of Group II is reciting the same printer as the claims of Group III, but in varying scope. More particularly claim 17, which is the only independent claim in Group II, recites a printer including a printing unit, a guide path, and rotating members, wherein one of the rotating members is more narrowly defined as having a periphery made of a material to which ink is not easily adhered. Claims 18 and 20, which are two independent claims in Group III, each recite a printer including a printing unit, a guide path, and rotating members, wherein one of the rotating members is more narrowly defined as being either one or two pair of first and second resist rollers, a switching mechanism, a driving source for the switching mechanism, and means for controlling the driving source.

The differences between claim 17 and claims 18 and 20 is that claims 18 and 20 are narrower than claim 17 in more narrowly defining the rotating member as either one or two pair of first and second resist rollers, a switching mechanism, a driving source for the switching mechanism, and means for controlling the driving source. But these differences do not amount to forming a combination and subcombination between claim 17 (i.e., Group II) and claims 18-20 (i.e., Group III). Thus, Applicant respectfully submits that the Restriction Requirement is improper.

In addition, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants respectfully traverse the Restriction Requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner, whereas it would clearly be burdensome on Applicants to be required to file, prosecute and maintain separate applications and patents on the identified.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-20 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Registration No. 25,599
Attorney of Record
Gay Ann Spahn
Registration No: 34978



22850

Tel. No.: (703) 413-3000;
Fax No.: (703) 413-2220; and
E-mail Address: gspahn@oblon.com.

GJM/GAS:ycs

I:\atty\gas\Client 6195\Matter 0074\Prov Elxn (Rsp to Rstrxn Rqmt) DUE 10 04 01.wpd